

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-14 and 17-18 are pending. Claims 1, 2, 5, 8, 13, 14, 17, and 18, which are independent, are hereby amended. Claims 15 and 16 were previously canceled without any prejudice and disclaimer to the subject matter.

No new matter has been introduced. Support for this amendment is provided throughout the Specification and specifically at page 4, line 22-page 5, line 14; page 10, line 25-page 12, line 1; page 14, line 24-page 16, line 13; and page 27, line 3-page 28 line 19. It is submitted that these claims, as originally presented, were in full compliance with the requirements of 35 U.S.C. §112. Changes to claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicant is entitled.

II. REJECTIONS UNDER 35 U.S.C. §103(a)

Claims 1-14 and 17-18 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. US 7,099,288 to Parker et al. (hereinafter, merely “Parker”) in view of U.S. Patent No. 6,538,990 to Prorock (hereinafter, merely “Prorock”).

Claim 1 recites, *inter alia*:

“...wherein said client terminal generates a request message embodied by an electronic mail message that contains in the message body at least one character indicating an IP address of said client terminal, and said client terminal sends out the request message to said host terminal via a transmission mail server,

wherein said host terminal acquires the request message via a reception mail server, said host terminal extracts the IP address of said client terminal from a description content of the message body of the request message, said host terminal stores the extracted IP address in a table, said host terminal selects at least one IP address from the table and generates a reply message embodied by an electronic mail message containing in the message body at least one character indicating the selected at least one IP address, and said host terminal sends the reply message to said client terminal via the transmission mail server...”
(emphasis added)

As understood by Applicant, Prorock relates to an address resolution protocol (ARP) used to identify a media access control (MAC) address from an IP address. In contrast, the claim invention is directed to obtaining an address of a peer by extracting a character string for an IP address included in the a body of an email message. Prorock is different from the claim invention in that Prorock fails to teach or suggest extracting an IP address from the body of an email message and instead merely teaches obtaining an address from an entry .

The claimed invention, as recited in claim 1, is distinguished from Prorock in that the claimed invention supports the exchange of IP addresses using only an existent infrastructure, i.e. the email system and does not require a dedicated server. Indeed, the present invention describes that an exchange is quite easy since it only requires the use of a simple tool, i.e., the email system (page 2, line 25 – page 3, line 9, page 10, line 25 – page 11, line 10 of the Specification).

Applicant submits that a hypothetical combination of Parker and Prorock would require a dedicated server for converting a telephone number into an IP address and therefore cannot achieve the claimed feature using a simple structure. As such, the combination would be distinctly different from the claimed invention with respect of the advantage provided as well as the structure required.

The Office Action notes that “there is a need for a way to allow two or more individual users to establish interactive connection sessions over the internet without requiring overt knowledge of the other’s IP address”. To remedy the deficiency, the Office Action cites Prorock. However, ARP as taught by Prorock is a technique for converting a logical address (local IP address) into a physical address (MAC address) and not a technique for obtaining an IP address of a peer. Rather, ARP is a technique for obtaining a MAC address or a peer by referring to an already known IP address of a peer. As such, Prorock is radically different from the claimed invention in respect of the process performed and the objective to be achieved.

The claimed invention uses email to exchange IP address. As such, it is capable of obtaining mutual addresses on the internet (page 14, lines 1-12). However, ARP of Prorock is a technique used only on a LAN and is merely capable of obtaining a MAC address by referring to an IP address on a LAN. In other words, the IP address as referred to in Prorock is limited to a private address.

In contrast, the IP address as referred to in the claimed invention is not limited to a private address. Rather, the advantage of the claimed invention is allowing peer-to-peer connection by exchanging global addresses over the internet (page 14, line 1-12). As such, the claimed invention is fundamentally distinguished from the teaching of the references, either alone or in combination.

Furthermore, the claimed invention is different from Prorock in that, while messages are transferred via “transmission mail server” and the “reception mail server” in the claimed invention, the technique of Prorock is used only on a LAN and does not utilize mediation of a mail server.

Therefore, Applicant submits that claims 1-14 and 17-18 are patentable.

III. DEPENDENT CLAIMS

The other claims in this application are each dependent from one of the independent claims discussed above and are therefore believed patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

Similarly, because Applicant maintains that all claims are allowable for at least the reasons presented hereinabove, in the interests of brevity, this response does not comment on each and every comment made by the Examiner in the Office Action. This should not be taken as acquiescence of the substance of those comments, and Applicants reserve the right to address such comments.

CONCLUSION

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicant respectfully requests early passage to issue of the present application.

In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited references, it is respectfully requested that the Examiner specifically indicate those portions of the references providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

Respectfully submitted,

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